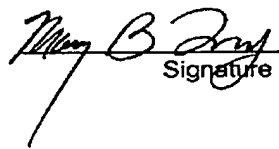


Doc. Code: AP.PRE.REQ

(Modified PTO Form SB/33)

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Application Number <b>09/834,208</b>
In re Application of: Oxygen Mask		
Docket Number 0022.010001		Filed April 13, 2001
Art Unit 3731	Examiner M. Mendoza	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a Notice of Appeal</p> <p>The review is requested for the reasons stated on the attached sheets. Note: No more than five (5) pages may be provided.</p> <p>I am the:</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 3.73(b) is enclosed.</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number: <b>50,007</b>.</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <p>NOTE: Signature of all the inventors or assignees of record of the entire interest or their representatives are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>		

  
Signature  
  
Mary B. Tung  
Typed or printed name  
  
410-451-2707  
Telephone number  
  
November 25, 2005  
Date

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Re: Application No. **09/834,208**

Confirmation No. 3950

Filing Date : April 13, 2001

Examiner: M. Mendoza

Applicant: G. Thomas Wolf

Art Unit: 3731

For: **Oxygen Mask**

Docket No. 0022-010001

**Notice of Appeal from the Examiner to the  
Board of Patent Appeals and Interferences**

Mail Stop: **AF**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

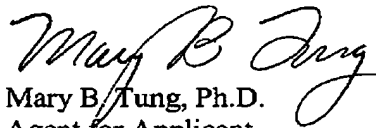
The Applicant hereby appeals to the Board of Patent Appeals and Interferences from the Final Office Action Mailed August 25, 2005. Claims 5-10, 12 and 13 have been at least twice rejected as required under 37 C.F.R. 1.17(b). The claims that the Applicant wishes to appeal are claims 5-10 and 12-18.

The appeal of claims 5-10, 12 and 13 is a reinstatement of an appeal requested by Applicant in a Notice of Appeal filed July 19, 2004. Prosecution was reopened by the Examiner in the Non-Final Office Action mailed September 8, 2004, wherein Finality was withdrawn. Consequently, the Applicant is applying the previously-paid appeal fee of \$165.00 toward the current appeal fee of \$250 (small entity), as provided in M.P.E.P. § 1204.01. Therefore, the Applicant believes that the fee required for this Notice of Appeal under 37 C.F.R. § 1.27 is satisfied and it is not believed that any other fees are required. However, if additional fees are

Serial No. 09/834,208

required to prevent abandonment of the present application, the Commissioner is authorized to charge any such fees to the credit card listed on the attached Form PTO-2038.

Respectfully submitted,



Mary B. Tung, Ph.D.  
Agent for Applicant  
Registration No. 50,007

Date: November 25, 2005

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Re: Application No. 09/834,208

Confirmation No. 3950

Filing Date : April 13, 2001

Examiner: M. Mendoza

Applicant: G. Thomas Wolf

Art Unit: 3731

For: Oxygen Mask

Docket No. 0022-010001

**Attachment to the Pre-Appeal Brief Request for Review****Mail Stop AF**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In reply to the Final Office action mailed August 25, 2005, Applicant submits the following Request for Review, as provided under the Pre-Appeal Brief Conference Pilot Program, published in the PTO Official Gazette on July 12, 2005.

It is not believed that an extension of time or fees are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if an extension of time is necessary to prevent abandonment of this application, then such extension of time is hereby petitioned under 37 C.F.R. § 1.136(a).

***Arguments and Remarks***

Review of this Application is respectfully requested.

Claims 5-10 and 12-18 are under consideration, with claims 5, 8 and 14 being independent claims. Claims 1-4 were originally filed. Claims 5-10 were added in the amendment filed February 8, 2004, claims 11-13 were added in the amendment filed July 19, 2004 and claims 14-18 were added in the amendment filed June 29, 2005. Claim 4 was cancelled in the

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amendment filed February 8, 2004 and claims 1-3 and 11 were cancelled in the amendment filed June 29, 2005.

To more clearly restate the Applicant's position for the purpose of the present Request for Review, introductory Remarks from the Applicant's Reply under 37 C.F.R. 1.111, filed June 29, 2005, have been repeated herein. Remarks regarding the Final Office Action mailed August 25, 2005 will be included in full in the Applicant's reply to the Final Office Action, and summarized herein, as included below. Only rejections directed to pending claims 5-10 and 12-18 are discussed herein.

The Applicant draws attention to the Examiner's notation in the Office Action mailed February 18, 2005 (see page 2, first paragraph) that "both the Examiner and the Examiner's Primary did not find any allowable subject matter in the application," which was repeated from the Interview Summary mailed on December 15, 2004. The Applicant's representative hereby offers a concern that the Examiner had reached a conclusion about the allowability of any future claims without fully and objectively considering the Applicant's claims.

The Applicant is also concerned about the seemingly unnecessary amount of prosecution that has occurred in this case. Finality has been improperly imposed, then withdrawn on four (4) separate occasions: May 6, 2003; May 22, 2003; November 7, 2003 and September 8, 2004. Prosecution was also reopened by the Examiner after the Applicant filed a Notice of Appeal on July 19, 2004. The Examiner rendered moot most of the arguments<sup>1</sup> made by the Applicant and thus the Examiner did not address the Applicant's arguments. As a result, the Applicant has been given little guidance as to what limitations in the claims would overcome the concerns of the Examiner. Also, multiple interviews, both in person (July 13, 2004) and by telephone (at least on October 20, 2003, November 30, 2004 and December 3, 2004) have taken place with Examiner Mendoza, Primary Examiner Dawson, and most recently on May 5, 2005, with Supervisory Patent Examiner Anh Tuan Nguyen. At the advice of the Examiner in the Interview Summary of the October 28, 2003 telephonic interview, the Applicant inserted "oxygen mask" into the body of the claim 5 in the response filed February 8, 2004 (see the Examiner's Interview Summary Statement, part of Paper No. 12). Despite following the advice of the Examiner, the claims were inexplicably rejected in the Action mailed April 19, 2004. The Examiner's apparent rationale is based on his assertion that no structural limitations have been made for an oxygen

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<sup>1</sup> Applicant assumes that he withdrew all respective standing rejections when rendering Applicant's arguments moot.

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mask and that any mask that could be used to breathe oxygen meets the limitations of the claims. Thus, with this belated rationale, the Examiner appears to have entirely changed the basis for rejection(s), and led to the Examiner's withdrawal of finality in the Action Mailed September 8, 2004.

***Rejection of Claims under 35 U.S.C. 103(a)***

The examiner has rejected claims 5-10 over Rudolph (U.S. Patent 5,265,595), in the Final Action mailed April 19, 2004, Page 2, paragraph 3 (rendered moot in the Final Action mailed September 8, 2004 after Applicant's persuasive arguments, and in view of new grounds for rejection, see page 2, paragraph 2).

The examiner has rejected pending claims 5-13 over Norfleet (U.S. Patent No. 6,418,929), in view of Dyrud (U.S. Patent No. 5,819,731) in the Non-final Action mailed September 8, 2004, Page 2, paragraph 4 (rendered moot in view of the new grounds of rejection in the Non-Final Action mailed February 18, 2005, see page 2, paragraph 1).<sup>2</sup>

The examiner has rejected pending claims 5-13 over Hudson (U.S. Patent No. 2,843,121) in the Non-Final Action mailed February 18, 2005, Page 3, paragraph 4 (apparently maintained in the Final Action mailed August 25, 2005, see pages 2-4, paragraphs 1-7, and pages 5-8).

The examiner has also rejected claims 14, 15, 17 and 18 over Hudson (the '121 patent) in the Final Action mailed August 25, 2005 (see page 5, paragraphs 9, 13, 14, 15, and 16).

The examiner additionally rejected claim 16 as being unpatentable over Hudson ('121 patent) in view of Dyrud ('595 patent) in the Final Action mailed August 25, 2005 (see page 8, paragraph 18).

Regarding the pending rejection of claims 5, 7, 8 and 10, the examiner stated that "Hudson fails to teach a pair of bands extendible to loop over and around each ear of the patient." Without providing a motivating statement *from the art*, that provides a nexus to the primary reference, the examiner stated that "it is well known in the art of masks to secure a mask using loops around a user's ears as an alternative to having a strap/band around the user's head as evidenced in U.S. Patents 2494406, 2798483, 4801473, 4941470, 5701892, 58197731, 6079980, 6095143, and 6394090," without specifically pointing out the relevant sections. The

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<sup>2</sup> As the rejections over Dyrud and Norfleet as primary references have been withdrawn ("rendered moot"), they will not be addressed by the Applicant herein.

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examiner also provided evidence by citing U.S. Patent No. 5,701,892 (col. 2, lines 32-33) and 5,819,731 (col. 1, lines 23-29) that "it is well known in the art of masks to secure a mask using loops around a user's ears to prevent entanglement of the user's hair."

The examiner failed to address the additional limitations of claim 5, 7, 8 and 10: 1) a pair of elastic bands, 2) both ends of each pair affixed at points of attachment to each of both sides of said oxygen mask, said bands extendible to loop over and around each ear of the patient and 3) adjustably securable to said patient by pulling the ends anteriorally through said points of attachment.

Regarding claims 6 and 9 (page 6, paragraph 11 of the action), the examiner only addressed the limitation of four separate points of attachment, citing *St. Regis v. Bemis CO.*, 193 USPQ 8, and using as evidence U.S. Patent Nos. 2,494,406, 2,798,483, 4,941,470, 5,701,892, 5,813,398 and 6,394,090, without specifically pointing out the relevant sections. Again, the examiner failed to address all the limitations of the claims or provide motivating statements from the art, as discussed regarding claims 5, 7, 8 and 10, *supra*.

Regarding claims 11-13 (page 6, paragraph 12 of the action), the examiner only addressed the limitation of the use of a flap valve, and using as evidence U.S. Patent Nos. 4,098,271 and 4,865,027. Again, the examiner failed to address all the limitations of the claims or provide motivating statements from the art, as discussed regarding claims 5, 7, 8 and 10, *supra*.

Regarding claim 14 (page 6, paragraph 13 of the action), claim 15 (page 7, paragraph 14), claim 17 (page 7, paragraph 15), and claim 18 (page 8, paragraph 16)<sup>3</sup> the examiner asserted that Hudson taught the structural limitations recited in claim 14 (a face mask molded from plastic to form a soft, one-piece covering for the mouth and nose of the patient, ... form a breathing chamber about the mouth and nostrils of the patient when the oxygen mask is positioned on the patient's face,) and using as evidence the same patents he used as evidence on page 5, paragraph 10, without specifically pointing out the relevant sections. The examiner repeated his arguments regarding the limitation of the ear loops and four separate points of attachment as discussed regarding claims 5, 7, 8 and 10 and claims 6 and 9, *supra*. Again, the examiner failed to address

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<sup>3</sup> The applicants assume that the examiner intended to include the rejection he set forth over independent base claim 14 into the rejection of claims 15, 17, and 18.

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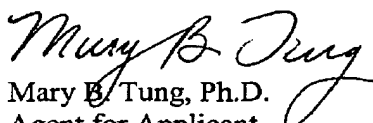
all the limitations of the claims or provide motivating statements from the art, as discussed regarding claims 5, 7, 8 and 10, *supra*.

The examiner has further rejected claim 16 over Hudson in view of Dyrud (the '731 patent; page 8, paragraphs 17 and 18). The applicant's arguments regarding Hudson have been discussed, *supra*. The applicant's arguments regarding Dyrud et al. in the paper filed December 8, 2004 (see page 4, and pages 5-6 of the Applicant's reply filed July 19, 2004) were rendered moot by the examiner in the paper mailed February 18, 2005. Additionally, the examiner has failed to cure the deficiency of Hudson, as the ear loops of Dyrud et al. extend around the back of the head, and thus do not teach the limitation of claim 16 that requires "a pair of elastic bands, both ends of each pair *affixed to each of both sides* of said mask, ...". The ear loops of Dyrud et al. are not both affixed to each of both sides of the mask.

Therefore, the examiner has failed to set forth a proper *prima facie* case of obviousness based upon the failure to address all the limitations of the claims. Additionally, the applicants assert that the examiner has used forbidden hindsight reconstruction to craft the rejections, as he has *never* provided a motivation to combine the references without using the Applicant's own disclosure as a guide and apparently his own opinion of what is known in the art, as maintained by the Applicant throughout the prosecution history of the case.

The Applicant respectfully requests a favorable review of the application in light of the Arguments and remarks herein.

Respectfully submitted,

  
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Date: November 25, 2005

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